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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/737,492	03/19/97	BURMEISTER	

QM31/0106

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EXAMINER	
PREDILIC, P	
ART UNIT	PAPER NUMBER
3735	

DATE MAILED: 01/06/99

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/737,492	03/19/97	BURMEISTER	P 563.2-6252

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QM31/1169

EXAMINER

PREBILIC, P

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

11/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/737,492

Applicant(s)

Burmeister et al

Examiner

Prebilic

Group Art Unit

3738

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE ONE (1) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on Sept. 4, 1998
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 21-27 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 21-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The Applicant filed an amendment on September 4, 1998 copying claims 1 and 4-9 from US Patent 5,601,593 as claims 21-27 of the present case; it is noted that claim 26 contains a typographical error which renders it indefinite. In response to the amendment filed September 4, 1998, the Examiner could not set up an interference with the US Patent 5,601,593 because the Applicant has not made an adequate showing under 37 CFR 1.607.

Claim Rejections - 35 USC § 112

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 is dependent upon a non-existent claim 46 and thus, its scope is indefinite; it was probably intended to depend from claim 25 instead so that Examiner will treat claim 26 as if it depends from claim 25 instead.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. An analysis of claims 25 and 26 of the present claims reveals that "the casing of elastomer" and "wires embedded in the casing" do not have original support and

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constitute new matter. It is noted that Applicant cites page 1 of the original specification as providing support, but the Examiner finds no support thereon. Moreover, if claim 26 were made to depend from claim 25 it would contain the same new matter by reference thereto.

Interference

Claims 21-27 are rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,601,593 was granted; see MPEP 2307. US Patent 5,601,593 issued on February 11, 1997. The present claim set was not filed until September 4, 1998. Also, the first set of amended claims (i.e. the first amendment to the application) were not filed until February 20, 1998. For this reason, only the originally filed claims (filed May 18, 1995) were filed before the 1 year anniversary date of the patent. Therefore, an analysis of those claims alone is required to determine if the Applicant was claiming the same or substantially the same invention within one year; see MPEP 2307.

An analysis of the originally filed claims clearly shows that the Applicant was not claiming the same or substantially the same invention within one year. Specifically, the originally filed claims did not claim "two groups of wires meshed together" (see claim 21), "a casing of elastomer" (see claim 25), "two groups of wires embedded in the casing" (claim 25), "two groups of wires of material having different shape memories" (see claims, 21, 25 and 27), "A method of changing the configuration of a stent placed in a body tube" (claim 27), of "a specific application of one of heat or cold" (claim 27).

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Claims 21-27 of this application have been copied from U.S. Patent No.5,601,593 for the purpose of an interference.

The Applicant has failed to comply with the requirements of 37 CFR 1.607 for the following reasons. The Applicant needs to provide the following information in response to this Office action in order to comply with 37 CFR 1.607:

- (1) Present a proposed count;
- (2) Identify at least one patentable application claim to be designated as corresponding to the count and explain why;
- (3) Identify at least one patentable patent claim to be designated as corresponding to the count and explain why; and
- (4) Explain how any new application claim satisfies the one-year requirement under 35 USC 135(b) -- Applicant must have been claiming the same patentable invention as the patent before one year after the issuance of the patent. Since the patent claims were copied after one year, Applicant must show that the application contained at least one other claim that is directed to the same patentable invention as the copied claims. Since Applicant is the senior party, no allegation of priority or evidence of priority is required under 37 CFR 1.608 (a) or (b).

Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to specifically apply each limitation or element of each of the

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copied claim(s) to the disclosure of the application. See 37 CFR 1.607(a)(5). THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
Art Unit 3738